

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Jonathan Dale
Serial No:	10/782,472
Date Filed:	February 18, 2004
Group Art Unit:	3629
Examiner:	Gabrielle A. McCormick
Confirmation No.	4871
Title:	DYNAMIC VIRTUAL ORGANIZATION MANAGER

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants request review of the rejections to the Application outstanding in the Final Office Action transmitted February 3, 2009 (“*Office Action*”) and the Advisory Action dated April 16, 2009 (“*Advisory Action*”). Claims 1-25 are pending in the Application, and the Examiner rejects all pending claims. As the rejections contain clear factual and legal deficiencies, Applicants respectfully request review of Claim 19 and favorable action in this case.

I. Rejections under 35 U.S.C. § 112

The Examiner rejects Claim 19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. With respect to Claim 19, the Examiner asserts that Applicant has not defined any means to determine a provider as satisfactory or to rank those that are satisfactory. *Office Action*, p. 3. The claim language itself, however, clearly describes “determin[ing] whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and rank[ing] each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.” With regard to determining whether the service provider is satisfactory, the specification recites that, by “[u]sing elements such as service registry 24, organization agent 22 can discover one or more potential services 18 for fulfilling a specified business function.” P. 10. Moreover, “[o]rganization agent 22 queries the identified services regarding specific service descriptions at step 118. This permits organization agent 22 to further refine the list of potential services 18 for fulfilling the business function requirements.” P. 19, ll. 22-24. With regard to ranking each of the satisfactory service providers, the specification recites that “organization agent 22 ranks the matching services 18 according to appropriate criteria at step 124. For example, in the purchasing context, organization agent 22 may arrange various product bids based upon cost, delivery time, and other suitable criteria.” P. 20, ll. 2-5. Accordingly, Applicant has provided means to determine a provider as ‘satisfactory’ and means to rank those that are satisfactory. Thus, Applicants respectfully submit that the rejection of Claim 19 under § 112, first paragraph, contains clear factual and legal deficiencies.

II. Rejections under 35 U.S.C. § 103

The Examiner rejects Claim 19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0023499 to Das, et al. (“*Das*”) in view of U.S. Patent

Publication No. 2001/0051913 to Vashistha, et al. ("*Vashistha*"). Applicant respectfully traverses this rejection and submits that *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest the combination of limitations recited in Claim 19.

Consider Applicant's independent Claim 17, Claim 18, and Claim 19, which recite:

17. A computer readable medium encoded with logic for automated management of business services, the logic operable when executed to perform the steps of:

establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;

accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator;

for each of the identified service providers:

communicating with the service provider to determine feature interfaces for interacting with the service provider;

accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; and

determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and

ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.

18. The computer readable medium of Claim 17, the logic further operable when executed, for each of the identified service providers, if the service provider is satisfactory, to negotiate variable service descriptors using a second one of the feature interfaces for the service provider, wherein ranking each of the satisfactory service providers further comprises ranking each of the satisfactory service providers based on the service descriptors and the variable service descriptors.

19. The computer readable medium of Claim 18, the logic further operable when executed to perform the step of accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest "accessing a first one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; . . . if the service provider is satisfactory, negotiating a plurality of variable service descriptors using a second one of the feature interfaces for the service provider; . . . and

accessing a third feature interface of the highest ranking one of the satisfactory service providers to authorize performance of the service,” as Claim 19 requires. As teaching the claimed service providers, the *Office Action* points to *Das*’s product vendors of ¶ 66. The *Office Action* then assumes that the claimed “feature interfaces for interacting with the service provider” must be determined because *Das* teaches that services are identified in ¶ 50. *Office Action*, p. 7. In the *Advisory Action*, the Examiner maintains that each of the first, second, and third feature interfaces “are inherently comprised in the networked data processing system” of *Das*. To show inherency, however, the Examiner must show that the missing elements are necessarily present. M.P.E.P. § 2112. That is simply not the case here. The cited references do not show even a single feature interface, let alone three, and the Examiner provides no justification for how any feature interfaces, let alone three specific feature interfaces as claimed, are necessarily present in the cited references. For this reason, the rejection under § 103 contains clear legal deficiencies and should be withdrawn.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application. Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a stylized flourish at the end.

Kurt M. Pankratz
Reg. No. 46,977

Date: May 4, 2009
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